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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,601	05/20/2004	Lawrence W. Arway	STD 1137 VA/41213.606/PD	7394
7590	09/13/2006		EXAMINER	HENDERSON, MARK T
DINSMORE & SHOHL LLP One Dayton Centre Suite 1300 One South Main Street Dayton, OH 45402-2023			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/849,601	ARWAY ET AL.	
	Examiner	Art Unit	
	Mark T. Henderson	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 May 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4,6-12,14,16-24,26,28-31 and 35-41 is/are rejected.
- 7) Claim(s) 3,5,13,15,25,27,32-34,42 and 43 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>8/16/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 4, 8-12, 14, 18-23, 26, 28, 36-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Laurash (5,486,021).

Laurash discloses in Fig. 1, 2 and 4, a label comprising: a strip of release material (108); a first printable label (106) with a release coating on a portion thereof (124), and a second

surface with a first pressure sensitive adhesive (120); wherein the first label (106) is adhered to the strip of release material (108) by the first pressure sensitve adhesive (120); a second printable label (104) having a second surface with a second pressure sensitve adhesive (110), wherein the second label (104) is adhered to the strip of release material (however, not directly) by the second adhesive (110) adjacent the first label (106); wherein the second label (104) further includes an additional label (112a-c, seen in Fig. 4); wherein the additional labels (112-a-c) are defined by a die cut (114); wherein the first printable label (106) includes an additional label (124) defined by a die cut (130, as seen in Fig. 2); wherein the release covers substantially all of the first surface (see Fig. 2) of the first label (106); wherein the first printable label (106) is printable(Col. 5, lines 58-63), wherein the printable area and indicia is inherently covered by a release coating and obscured from view when the second label is secured to the first label; wherein the first surface of the second label (104) includes an area for printing (Col. 5, lines 52-54).

In regards to **Claims 9 and 19**, the method of the first label being thermally printable, does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to print on the label in any manner.

In regards to **Claims 2, 4, 10, 11, 14, 20-22, 28, 37, 38, 40, and 41**, wherein the additional labels are manifest labels, and a customer receipt label; and wherein the printable

surface areas are for printing a return address and an outgoing address, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the additional labels and printing areas can be used in any desirable manner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6, 7, 16, 17, 29, 30, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurash.

Laurash discloses a label comprising all the elements as set forth in Claims 1 and 12, and as set forth above. However, Laurash does not disclose: wherein the length and width of the second label is less than the length and width of the first label; wherein the first label carries indicia to assist in placement of the second label.

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In regards to **Claims 6, 16, and 29**, it would have been obvious to one having skill in the art to construct the first and second labels in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. Therefore, it would have been to construct the labels with any desirable dimension, since applicant has not disclosed the criticality of having a particular size, and invention would function equally as well if constructed in any desirable size.

In regards to **Claims 7, 17, and 35**, wherein the indicia of the first labels is used to assist in placement of the second label; and wherein the printable surface areas are for printing a return address and an outgoing address, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, the first label indicia and the additional labels and printing areas can be used in any desirable manner.

3. Claims 24, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurash in view of Bulka (5,343,647).

Laurash discloses a label comprising all the elements as set forth in Claims 1 and 12, and as set forth above. However, Laurash does not disclose: wherein second pressure adhesive coating comprises repositionable adhesive coating.

Bulka discloses in Fig. 3, a label substrate (15) comprising repositionable adhesive (16) adhered to a release coating (14).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash's label with a label substrate comprising repositionable adhesive as taught by Bulka for providing a label substrate which can be removed and adhered onto another item.

Allowable Subject Matter

4. Claims 3, 5, 13, 15, 25, 27, 32-34, 42 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Konkol et al, Chess, Jenkins, Denklau et al, Arway et al, MacGregor et al, Roshkoff, Doll et al, Murphy, and Casagrande disclose similar labels.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

September 5, 2006



Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER